



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,713	10/09/2001	Patrick Pirim	20046H-00080	9181

7590 02/18/2005

Babak S Sani
Townsend and Townsend and Crew
Two Embarcadero Center 8th Floor
San Francisco, CA 94111

EXAMINER

PHILIPPE, GIMS S

ART UNIT	PAPER NUMBER
----------	--------------

2613

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,713

Applicant(s)

PIRIM, PATRICK

Examiner

Gims S Philippe

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19, 20 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-17, 19, 20, 22-28 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response To Amendment

1. The applicant's amendment received on November 26, 2004 in which claims 1-14, 19-20, and 25-28 were amended, claims 18 and 21 were canceled, and claims 29-31 were added has been fully considered and entered, but the arguments are not deemed to be persuasive.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. In addition, the format followed by the applicant for writing the claims is ambiguous.

4. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Most of the previously mailed Office action is repeated since the Examiner has not seen a significant change between the previous claim language and the amended claims.

Art Unit: 2613

Regarding claim 1, the applicant must clearly show the steps performed in the process. Such steps are not well shown. What is being claimed in the process is rather confusing. That section of the claim requires a preliminary encoding operation, an additional encoding operation, and a compression operation ... to reduce the number of binary signals by suppression of the majority of the binary signals of said flow whose value is determined within both possible values of such signals.

In line 4 of page 112 (or line 34 of the claim), the expression "i.e. comprising" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "i.e."), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). Also see line 6 of page 113 to correct the same type of problem in the claim.

In amended claim 1, line 47 (i.e., page 5), the expression "as regards the compression process" is not considered as a proper claim language

Note: The examiner has pointed out just a few of the problems of claim 1. It is the examiner's belief that a quick review by the applicant's representative will help in clarifying the claim and advancing prosecution. For example, the claim notes <<time constant>>. It is unclear to the examiner whether such language is part of the claim or added for explanation. It appears that the applicant followed a specification format rather than a claim format to claim what he/she believes to be patentable.

Art Unit: 2613

Claim 3, recites the limitation "said signals" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 3, line 12 also recites the expression: "*In order thus to restore the successive frames*". This expression is not considered to be a proper claim language for two reasons. First, it is the beginning of a new sentence in the middle of the claim, which renders the claim ambiguous because the steps of the process are not in a proper sequence. Second, it is not believe that the process claim needs give the reason for restoring the successive frames.

Claim 4, line 13, recites the expression "if any". This expression renders the claim indefinite since in one case the claim calls for non-displacement (second group of pixels) while the expression "if any" does not call for any displacement representation.

Claims 2-6 are also rejected by dependency to indefinite claim 1.

5. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example in lines 6 to 18 of page 118, the expression "*for the compression, it comprises, moreover, at least as regard the luminance in the said input video signal ...*" is vague and indefinite which make examination burdensome.

In addition, the acronyms must be within parenthesis. For example DP in line 23; CO in line 27. the i.e., of line 24 of page 118 renders the claim vague and indefinite because it is considered as a relative term.

6. Claim 7 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

7. Claims 8-9 are rejected by dependency. The applicant must review the language of claims 8-9 because they are indefinite also. For example, claim 9, lines 1-2 the expression "A device according to claim 7, characterized it comprises means ..." is considered vague and indefinite.

8. Claims 10-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claim 10, the phrase " with a less encoded datum " lines 14-15 renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed thereby rendering the scope of the claim(s) unascertainable. In other words,

Art Unit: 2613

there is no threshold in the claim to determine "*the less encoded datum*": See MPEP § 2173.05(d).

The compression must be either claimed as being performed by software; or the applicant must claim the circuit performing the compression.

Claims 11-27 are rejected by dependency to claim 10.

The rejection of claims 10-27 is maintained since the amendment does not reduce the burden on the examiner.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 10-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogata (US Patent no. 5,777,678).

Regarding claim 10, Ogata discloses a video compression apparatus comprising a motion analysis stage, comprising circuitry and/or software designed to identify a pixel of a current frame of a video whose contents correspond to a different pixel of a

Art Unit: 2613

previous frame of the video, and designed to produce datum coding motion between the pixel of the previous frame and the pixel of the current frame, and at least one other video processing stage of circuitry and /or software interconnected with the motion analysis stage to effect compression of the video (See Ogata fig. 1, motion vector detector 11, motion compensation item 103 and col. 3, lines 11-19, lines 28-67 and col. 4, lines 1-29).

As per claims 11-27, the illustration of fig. 2A, 2B, 4, and 5, provides the limitation of these claims as shown from col. 6 to col. 20.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 28 and 31, the phrase "circuit and software" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "circuit and software"), thereby rendering the scope of the claim(s) unascertainable. In other words, the claim must specify whether the steps are

Art Unit: 2613

performed by instructions of software or by the means plus function of a circuit See MPEP § 2173.05(d).

In claim 28, the circuit and or software are considered as two different configurations in a claimed invention. The claim must state whether the steps for the process are performed by the software or by the circuit.

14. Claims 29-30 are allowed.

Remarks

15. In the previously mailed Office action, the examiner had shown a few examples of the language in the claims in order to help the applicant in making the proper correction. However, most of the amended claims do not differ much from the original claims.

In order to reduce the burden on the examiner, and to avoid future infringement lawsuit, the applicant must clearly state (*i.e., by stating the means plus function or the specific steps*) what he/she believes is the invention.

The applicant must adopt a format to write the claims. It is the examiner's impression that applicant writes the claim as a specification with no specific guidelines. Further, the applicant is urged to present a clean copy of the claims.

Art Unit: 2613

It should be noted, however, that newly presented claims 29 and 30 are properly written, and the applicant should use those claims as a guideline to correct the rejected claims.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gims S Philippe whose telephone number is (703) 305-1107. The examiner can normally be reached on M-F (9:30-7:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S Kelley can be reached on (703) 305-4780. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2613

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Gims S Philippe
Primary Examiner
Art Unit 2613

GSP

February 17, 2005